

## **REMARKS**

Claims 23-222 are pending.

As an initial matter, Applicant thanks the Examiner for examining all of the pending claims and indicating that claims 29-32, 39-42, 60, 61, 63, 70, 106, 107, 109, 116, 152, 153, 155, 162, and 204 include allowable subject matter.

In the Office Action, claims 23-28, 33-38, 43-59, 62, 64, 68, 69, 71, 75-105, 108, 110, 115, 117, 121-151, 154, 156, 160, 161, 163-203, and 205-222 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,887,994 to Bedford ("Bedford"). Claims 23, 24, 33, 34, 43, 90, 136, and 191 are the only independent claims included in the rejection.

Applicant respectfully requests that the Examiner reconsider and withdraw the Section 102(b) claim rejection because Bedford does not disclose all of the features recited in independent claims 23, 24, 33, 34, 43, 90, 136, and 191. For example, Bedford does not disclose a product applicator including, among other features, "at least one layer of a flexible material covering . . . [a] flexible support, the flexibility of said at least one layer being greater than the flexibility of the support," as recited in claims 23, 24, 33, and 34. Bedford also does not disclose flexible "material having a greater flexibility than the flexibility of [a] support," as recited in claims 43, 90, 136, and 191.

The Office Action at p. 2 cites reference numerals 13, 36 of Bedford for the asserted disclosure of a flexible support, and it cites reference numeral 15 of Bedford for the asserted disclosure of flexible material. Applicant respectfully submits that the Section 102(b) claim rejection should be withdrawn because Bedford's stick handle, e.g., stick handle 13, and foam applicator 15 do not correspond to the recited flexible

support and flexible material, respectively. More specifically, Bedford does not disclose the foam applicator 15 having a greater flexibility than the flexibility of the stick handle

13. For example, Bedford does not appear to mention flexibility or relative flexibility.

Thus, the claim rejection appears to be based on a theory of inherency.

Applicant respectfully submits that the Office Action does not satisfy the requirements for a proper inherency-based rejection, as dictated by legal precedent.

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”

“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

(citations omitted) (emphasis supplied) (cited in M.P.E.P. § 2112). As noted in the Office Action at p. 2, Bedford states that “[t]he stick handle 13 may be made of plastic, wood or paper, or other material” (col. 2, lines 9-12), and Bedford also indicates that the foam applicator 15 is an open cell polyurethane foam (col. 1, lines 64-65). Such materials, however, would not **necessarily** provide the foam applicator 15 with a flexibility greater than the flexibility of the stick handle 13. In particular, when using those materials, it would be possible to have the foam applicator 15 less flexible than the stick handle 13. Consequently, the Section 102(b) of independent claims 23, 24, 33, 34, 43, 90, 136, and 191 should be withdrawn.

The Section 102(b) rejection should also be withdrawn for additional reasons. For example, claim 23 recites an application portion configured to apply a cosmetic product and flexible material “impervious to the cosmetic product.” Bedford does not

disclose the recited flexible material impervious to cosmetic product and, thus, independent claim 23 should be allowable over Bedford for this additional reason.

Regarding independent claims 24 and 34, Bedford does not disclose the recited “flexible support [that] comprises cardboard.” Contrary to the statement in the Office Action at p. 2, Bedford does not mention “hard paper.” Rather, Bedford at col. 2, line 10 refers to “paper” without describing it as being hard or otherwise indicating any particular type of paper. Bedford’s mere mention of “paper” does not constitute a disclosure of the cardboard recited in independent claims 24 and 34.

With respect to independent claims 90 and 136, Bedford does not disclose the recited layer of flexible material “on [a] first planar surface at [a] gripping portion.” For example, the applicator 35 shown in Fig. 5 of Bedford does not correspond to the flexible material because it is not located at a gripping portion. Moreover, even though Fig. 5 appears to show the applicator 35 at the end of a flat stick handle, Bedford does not appear to disclose the applicator 35 being on a planar surface (e.g., Fig. 5 does not show how the applicator 35 is associated with its stick handle).

Moreover, the rejection of the method claims should be withdrawn because the Office Action lacks any support for the assertion that “the method claims . . . would have been inherently carried out in the operation of the device.” Office Action at p. 3. Referring to the discussion above regarding inherency-based rejections, the Bedford swab would not **necessarily** be used in the manner set forth in the method claims.

For at least these reasons, independent claims 23, 24, 33, 34, 43, 90, 136, and 191 and the method claims should be allowable over Bedford. Claims 25-28, 35-38, 44-59, 62, 64, 68, 69, 71, 75-89, 91-105, 108, 110, 115, 117, 121-135, 137-151, 154, 156,

160, 161, 163-190, 192-203, and 205-222 depend from one of independent claims 23, 33, 43, 90, 136, and 191 and, thus, these dependent claims should be allowable for at least the same reasons as the respective independent claim from which they depend.

In the Office Action, claims 65-67, 72-74, 111-113, 118-120, and 157-159 were rejected under 35 U.S.C. § 103(a) based Bedford.

Applicant respectfully submits that the Section 103(a) rejection should be withdrawn because claims 65-67, 72-74, 111-113, 118-120, and 157-159 depend from one of independent claims 43, 90, and 136 and, thus, these dependent claims should be allowable for at least the same reasons as the respective independent claim from which they depend. Furthermore, Applicant respectfully submits that the claim rejection should be withdrawn due to a lack of a *prima facie* case of obviousness.

In view of at least the reasons explained above, the claim rejections should no longer be applicable and pending claims 23-222 should be allowable. If the Examiner believes a telephone conversation or interview might advance prosecution, the Examiner is invited to call Applicant's undersigned representative (571-203-2774).

Applicant respectfully requests reconsideration of this application, withdrawal of the claim rejections, and timely allowance of the pending claims.


The Office Action contains a number of statements relating to the claims and the cited reference. Applicant respectfully declines to subscribe to any statement in the Office Action, regardless of whether it might be specifically mentioned above.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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